

REMARKS

Claims 1, 4, 7, 10, and 16-21 remain pending in the present application. Claims 16 and 17 were amended to correct some minor errors. The rejections set forth in the Office Action are respectfully traversed below.

Rejection under 35 USC § 102

Claims 1, 4, 10, 16, 17 and 19-21 were rejected under 35 USC § 102 over Ushiki et al. (JP 9-259391). However, it is submitted that nothing in the cited prior art teaches or suggests all the features recited in the present claimed invention, as amended.

For instance, the cited prior art fails to teach or suggest identifying a “type” of a portable telephone set, where the “type” of portable telephone set includes at least a communication protocol (or system) employed by the portable telephone set - the “communication protocol (or system)” including a protocol (or system) *suited* for making a communication while moving *and* a protocol (or system) which is *unsuited* for making a communication while moving. These features are described, for example, on page 1, lines 26-30 of the specification, wherein a mobile telephone system and a PHS telephone system are examples that correspond to the two different protocols/systems.

Ushiki merely describes identifying the “model” of the telephone set, such as a “digital 9600 telephone” and a “digital 2400 telephone.” However, both of these “models” employ the *same* communication system (or protocol). In other words, both of these “models” employ a

communication protocol that is only suited for making a communication while moving. **Ushiki** does not teach or suggest any identification between *different* communication protocols, such as between a communication protocol suited for mobile communication and a communication protocol unsuited for mobile communication. For at least these reasons, the present claimed invention, as amended, patentably distinguishes over the prior art.

#### **Rejections under 35 USC § 103**

Claims 7 and 18 were rejected under 35 USC § 103 over **Ushiki**. Independent claim 7, as amended, clarifies that the communication protocol includes a protocol suited for making a communication while moving, as well as a protocol unsuited for making a communication while moving. These features distinguish over the prior art as explained above. Furthermore, as noted in the Office Action, **Ushiki** does not teach or suggest a PC card. Therefore, claims 7 and 18 patentably distinguish over the prior art.

#### **Double Patenting Rejections**

Claims 1, 4, 7, 10 and 20 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1, 4, 7 and 10 of co-pending application Serial No. 09/957,081, in view of **Ushiki**.

However, these double patenting rejections are improper and should be withdrawn. First, application Serial No. 09/957,081 has only one pending claim 11. Second, application S/N '081 is

a divisional application of the present application, directed to Group IV, specified in the restriction requirement dated July 30, 2001, of the present application. As stated in the July 30, 2001, restriction requirement, Group IV (claim 11) was deemed to be a “*patentably distinct*” species of the claimed invention.” Therefore, the present double patenting rejections are contradictory with the earlier restriction requirement, and should be withdrawn.

**Information Disclosure Statement**

An Information Disclosure Statement was filed on February 4, 2004 (copy attached), along with a Change of Address request. The Examiner is respectfully requested to return the Form PTO/SB/08A initialed to indicate the Examiner's consideration of the references cited therein.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicant respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, appearing to read "John P. Kong", with a stylized, flowing script.

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